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10/511,304	10/15/2004	Takao Koyama	009682-138	9491

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EXAMINER
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NGUYEN, TUAN N

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3751

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Application Number: 10/511,304  
Filing Date: October 15, 2004  
Appellant(s): KOYAMA, TAKAO

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Wendi L. Weinstein  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 01/07/2010 appealing from the Office action mailed 06/09/2009.

**(1) Real Party in Interest**

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

**(2) Related Appeals and Interferences**

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

**(3) Status of Claims**

The following is a list of claims that are rejected and pending in the application:

Claims 21, 37, 51, 53, 55, 57 and 59-61.

**(4) Status of Amendments After Final**

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief except for the Amendment After Final filed January 7, 2010 to correct informality has been entered and the claim objection is hereby withdrawn.

**(5) Summary of Claimed Subject Matter**

The examiner has no comment on the summary of claimed subject matter contained in the brief.

**(6) Grounds of Rejection to be Reviewed on Appeal**

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being

maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

### **(7) Claims Appendix**

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

### **(8) Evidence Relied Upon**

US 6,428,235	TAKANASHI ET AL.	8-2002
US 4,065,215	OTSUKA	12-1977
US 4,979,840	MADAUS ET AL.	12-1990

### **(9) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 21, 37, 51, 53, 55, 57 and 59-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka in view of Takanashi et al. (hereinafter Takanashi) and Madaus et al. (hereinafter Madaus).

The Otsuka reference discloses a writing instrument (Fig. 1) having an ink occlusion body (16) as claimed; a pent tip (24a) including a capillary material (34a,34b) disposed in a writing part; and an ink guiding feed defined by a hollow tubular body (see Fig. 3). The Otsuka pent tip 24a does include a capillary material since it has a capillary force to draw ink from member 22 out onto the writing surface; however, the capillary mater of the pen tip is not capillary felt material. Since the ink guiding feed is a hollow tubular body that guides the ink between where 24b and where 24 are

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pointing to (see Fig. 1), it does meet the limitation of the ink guiding feed lacking any capillary material since it is not made from capillary felt material. The ink guiding feed between where 24b and where 24 are pointing to (see Fig. 1) acts as a guide for the ink from member 22 to the pen tip where 24a is pointing at; therefore, the claimed limitation is met. The ink guiding feed is hollow because it has passage therein.

Although the Otsuka reference is silent as to the material of the barrel being made out of transparent material, attention is directed to the Takanashi reference which discloses an analogous writing instrument, which further includes a barrel (12) and an ink guiding feed (18) made out of transparent material (see col. 8, lines 11-16) so as to check not only the residual ink quantity in the ink tank but also that in the collector (see col. 5, line 64 et seq.). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the barrel of Otsuka out of transparent material as, for example, taught by Takanashi in order to check not only the residual ink quantity in the ink tank but also that in the ink guiding feed area. In so doing, a sign of exhausting the ink fed from the ink occlusion body is inherently detected by visually observing the ink guiding feed via a visible part formed in the barrel. In regard to claim 51, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make only a portion of the barrel visible as claimed in a way similar to the portion (10) in Fig. 4 of Madaus. In regard to claims 53, 55 and 57, although the Otsuka reference is silent of the specific dimension of the ink guiding feed having an ink passage, the specific surface tension of the ink, and the specific viscosity of the ink as claimed, it would have been obvious to one of ordinary

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skill in the art at the time the invention was made to obtain an ink guiding feed having an ink passage cross-sectional area in the specific range as claimed and an ink having the specific surface tension and viscosity as claimed, since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. Re: claim 61, to make the pen tip and the guiding feed out of two difference members as claimed is met by the teaching of members 10 and 24 of Takanashi which would have been obvious to one of ordinary skill in the art at the time the invention was made.

#### **(10) Response to Argument**

With respect to Applicant's argument in the last paragraph of page 6, Examiner would like to point out that the ink guiding feed 24 of Otsuka is not made of capillary material. It, however, has the structure that causes capillary action. With respect to Applicant's argument in the last paragraph of page 7, claim 21 merely claims the ink guiding feed is visible via a visible part formed in the barrel. The modification of Otsuka in view of Takanashi and Madaus would result in a writing instrument with a transparent pen barrel design which obviously would allow visibility to the inner parts of the writing instrument and the ink guiding feed is one of those inner parts. It appears that Applicant's argument does not commensurate with the scope of the claim.

#### **(11) Related Proceeding(s) Appendix**

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

/Tuan N Nguyen/

Primary Examiner, Art Unit 3751

Conferees:

/Gregory L. Huson/

Supervisory Patent Examiner, Art Unit 3751

/Len Tran/

Supervisory Patent Examiner, Art Unit 3752